UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,008	06/04/2001	Atsushi Teshima	5-052US-FF	3645

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EXAMINER
TUCKER, WESLEY J

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No. 09/872,008	Applicant(s) TESHIMA, ATSUSHI
	Examiner Wes Tucker	Art Unit 2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 June 2001</u>.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-10</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>04 June 2001</u> is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All b)☐ Some * c)☐ None of:
        1.☒ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites "said image data generation means in the server generating image data representing an image which can be outputted by the second client device." It is unclear how the image data representing an image can be outputted by the second client device when it is generated in the server if it is not first transferred to the second client. The claim is treated below as if it read "outputted <u>to</u> the second client device instead of "outputted <u>by</u> the second client device."

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,658,167 to Lee et al.

3.   With regard to claim 1, Lee discloses an image registration system comprising a

first client device and a server which can communicate with each other, wherein

        said first client device (Fig. 1, element 110a) comprises

        first image data transmission means for transmitting to said server image data to

be registered, and

        the server (Fig.1, element 100) comprises

        image data receiving means for receiving the image data transmitted from said

first image data transmission means in said first client device,

        image data generation means for generating image data representing the same

image as an image represented by the image data received by said image data

receiving means and having a different form of representation therefrom (column 2,

lines 32-47 and Fig.2, element 220), and

        image data storage means for storing the image data generated by said image

data generation means so as to be accessible (column 2, lines 32-47).

        Lee discloses a system where data or digital images are transmitted to a server

and modified according to optimization for preferred use. The server optimizes the data

or generates new image data and inherently stores the data for use by the client.

4.   With regard to claim 2, Lee discloses the image registration system according to

claim 1, wherein said server (Fig.1, element 100) and a second client device (Fig. 1,

element 110b) can communicate with each other, said image data generation means in

the server generating image data representing an image which can be outputted by the

second client device (Fig.2, element 220).

5.   With regard to claim 3, Lee discloses the image registration system according to claim 2, wherein

said second client device (Fig. 1, element 110b) comprises

request data transmission means for transmitting to said server request data representing a request to transmit the image data stored in said image data storage means(Fig. 2, element 210), and

the server (Fig. 1, element 100) comprises

request data receiving means for receiving the request data transmitted from the request data transmission means in the second client device (Fig. 2, element 210),

image data retrieval means responsive to the request data received by said request data receiving means for finding from the image data storage means the image data suitable for image output by the second client device which has transmitted said request data out of the image data stored in the image data storage means in the server(Fig.2, element 210), and

second image data transmission means for transmitting to the second client device the image data found by said image data retrieval means (column 3, lines 30-40 and Fig.2, element 230). Lee discloses several clients connected to the server capable of transferring and requesting image data that would inherently be called from image storage in the server.

6.   With regard to claim 7, Lee discloses an image registration server which can communicate with a client device, comprising:

image data receiving means for receiving image data transmitted from said client device (Fig.2, element 210);

image data generation means for generating image data representing the same

image as an image represented by the image data received by said image data

receiving means and having a different form of representation therefrom (Fig. 2,

element 220); and

image data storage means for storing the image data generated by said image

data generation means so as to be accessible (column 2, lines 32-47).

Lee discloses a system where data or digital images are transmitted to a server

and modified according to optimization for preferred use. The server optimizes the data

or generates new image data and inherently stores the data for use by the client.

7.   With regard to claim 8, Lee discloses an image transmission server which can

communicate with a client device, comprising:

image data generation means for generating image data representing the same

image as an image represented by fed image data and having a different form of

representation therefrom (Fig.2, element 220);

image data storage means for storing the image data generated by said image

data generation means so as to be accessible (Fig.2, element 220);

request data receiving means for receiving request data representing a request

to transmit the image data stored in said storage means (Fig 2, element 210);

image data retrieval means responsive to the request data received by said

request data receiving means for finding from the storage means the image data

suitable for image output by the client device which has transmitted the request data out

of the image data stored in the storage means in the server(Fig. 2, element 220); and

image data transmission means (Fig.2, element 230) for transmitting to the client device the image data found by said image data retrieval means (column 2, lines 32-47 and column 3, lines 42-50). Lee discloses a system that modifies image data to a different form or representation in a server and then transmits the new image data to the client for use. The features of image data storage means, request data receiving means, image data retrieval means, and image data transmission means are all inherent to a network system.

8.   With regard to claim 9, Lee discloses an image registration server which can communicate with a client device, an image registering method comprises the steps of: receiving image data transmitted from said client device (Fig. 2, element 210); generating image data representing the same image as an image represented by the received image data and having a different form of representation therefrom (Fig. 2, element 220); and storing the generated image data so as to be accessible (column 2, lines 32-47 and column 3, lines 42-50). Storing the generated image data is inherent once it is created.

9.   With regard to claim 10, Lee discloses an image transmission server, which can communicate with a client device, an image transmitting method comprises the steps of:

generating image data representing the same image as an image represented by fed image data and having a different form of representation (Fig. 2, element 220);

storing the generated image data so as to be accessible;

receiving request data representing a request to transmit the stored image data (Fig. 2, element 210);

finding the image data suitable for image output by the client device which has

transmitted the request data out of the stored image data in response to the received

request data(Fig. 2, element 220); and

transmitting to the client device the found image data (Fig. 2, element 230 and

column 2, lines 32-47 and column 3, lines 42-50).

Lee discloses a system that modifies image data to a different form or

representation in a server and then transmits the new image data to the client for use.

The features of storing the generated image data, receiving request data, finding the

image data, and transmitting the image data are all inherent to a network system.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a
person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived
by the manner in which the invention was made.

Claims 4, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent 6,658,167 to Lee et al.

11.   With regard to claim 4, Lee discloses the image registration system according to

claim 3 (Fig. 1). Lee does not disclose a number-of-requests counting means for

incrementing the number of transmission requests issued by said second client device.

It is well known in the art that requests for data transfer must be acknowledged in a

handshaking method to exchange information. Examiner takes official notice. Those requests are inherently counted and acknowledged as they are received. Therefore it would have been obvious to one of ordinary skill in the art to use a number-of-requests counting means in order to acknowledge when and how many requests are received by the server and to transfer data accordingly.

12.   With regard to claim 5, Lee discloses the image registration system according to claim 3, wherein said server comprises a first server (Fig. 1). Lee does not disclose explicitly a second server, however he does disclose the use of the Internet. It is well known in the art that the Internet or any kind of computer network contains many servers that can communicate with one another. Examiner takes official notice. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use multiple servers and clients in operation in the same way as the first server and client.

13.   With regard to claim 6, Lee discloses the image registration system according to claim 3, wherein said server comprising a first (Fig. 1). Lee does not disclose explicitly a second server, however he does disclose the use of the Internet. It is well known in the art that the Internet or any kind of computer network contains many servers that can communicate with one another. Examiner takes official notice. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use multiple servers and clients in operation in the same way as the first server and client.

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Wes Tucker whose telephone number is 703-305-6700.

The examiner can normally be reached on 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

AMELIA M. AU
SUPERVISORY PATENT EXAMINER
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Wes Tucker
4-15-2004